

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 2-4, 7-11, 13-15, 18-22, 24-26, and 29-66 are presently active in this case, Claims 2, 4, 7-9, 11, 13, 15, 18-20, 22, 24, 26, and 29-39 having been amended, Claims 1, 5, 6, 12, 16, 17, 23, 27, and 28 having been canceled without prejudice or disclaimer, and Claims 43-66 having been added by way of the present Amendment.

Claims 10, 21, and 32 were indicated as being allowed. Claims 2-4 and 7-9 depend from base Claim 10, and thus are believed to be in condition for allowance. Claims 13-15 and 18-20 depend from base Claim 21, and thus are believed to be in condition for allowance. Claims 24-26 and 29-31 depend from base Claim 32, and thus are believed to be in condition for allowance.

Newly added Claims 43-66 are fully supported by the disclosure. Claims 44-50, 52-58, and 60-66 are supported by at least Claims 2-4, 7-9, and 37. Additionally, Claims 43, 51, and 59 are fully supported by at least the figures in the present application.

Claims 1, 2, 4, 12, 13, 15, 23, 24, 26, and 34-42 were rejected under 35 U.S.C. 102(e) as being anticipated by Ejima et al. (U.S. Patent Pub. No. 2001/0012065 A1). Claims 3, 14, and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. Claims 5-9, 11, 16-20, 22, 27-31, and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. in view of Komatsuzaki et al. (U.S. Patent No. 6,137,960). For the reasons discussed below, the Applicant requests the withdrawal of the art rejections.

Regarding the anticipation rejection of independent Claims 34-36, the Applicant notes that a claim is anticipated only if each and every element as set forth in the claims is found,

either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Ejima et al. reference clearly does not meet each and every limitation of the independent Claims 34-36.

Claims 34 and 35 recite digital cameras comprising, among other features, an optical system having a lens positioned on a front surface of a camera body, and a display device positioned on a top surface of the camera body, where the top surface abuts the front surface. Additionally, Claim 36 recites a method for protecting a digital camera, where the digital camera includes an optical system having a lens positioned on a front surface of a camera body, and a display device positioned on a top surface of the camera body, and where the top surface abuts the front surface. By way of illustration and not limitation, the present application depicts an embodiment of such a camera in Figure 7 where a display screen (10) is provided on a surface that abuts a surface having optical system (3). (See also page 14, lines 19-23, of the present application.) The Applicants submits that the Ejima et al. reference does not disclose such a configuration or method.

The Ejima et al. reference depicts and describes an electronic camera having a face (X1) including a lens (3) and a face (X2) including an LCD display. The face (X1) is described as being opposite to the face (X2). Faces (X1) and (X2) clearly do not abut one another. Accordingly, the Ejima et al. reference fails to anticipate a lens positioned on a front surface of a camera body, and a display device positioned on a top surface of the camera body, where the top surface abuts the front surface, as recited in Claims 34-36 of the present application.

Accordingly, the Applicant respectfully requests the withdrawal of the anticipation rejection of Claims 34-36. Additionally, the claims that depend from Claims 34-36 are considered allowable for at least the reasons advanced for the independent claim from which they respectively depend.

Regarding the obviousness rejection of independent Claims 11, 22, and 33, the Applicant notes that the basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicant submits that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 11, 22, and 33.

Claim 11 of the present application recites a digital camera comprising, among other features, a first cover device configured to cover a display device, and a second cover device that is configured to cover a lens, wherein said first cover and said second cover are separately provided on said camera body. Claim 22 recites a digital camera comprising, among other features, means for covering a display device, and means for covering a lens, where the means for covering the lens and the means for covering the display device are separately provided on the camera body. Claim 33 recites a method for protecting a digital camera comprising covering a display device with a first cover device, where a second cover device is provided that includes a member to cover and uncover the lens, and where the first

cover device and the second cover device are separately provided on the camera body. The Applicant submits that neither of the cited references teaches a cover for covering a display device, and a separately provided cover for covering a lens, as recited in Claims 11, 22, and 33.

The Ejima et al. reference describes an electronic camera having a face (X2) including an LCD display. An LCD cover (14) is described as being provided on the face (X2) to protect the LCD (6). As noted in the Official Action, the Ejima et al. reference does not disclose any cover device to cover the shooting lens (3).

The Komatsuzaki et al. reference describes a camera having a slide case for covering a lens of the camera. The slide case can also slide over the LCD. The slide case is described as a “single piece.” (Column 4, lines 8-9.) The slide case is clearly a unitary structure.

Therefore, neither of the cited references teaches a separately provided cover for covering a lens, as recited in Claims 11, 22, and 33. Furthermore, based on the teachings of the Komatsuzaki et al. reference, one of skill in the art would have been motivated to provide a single piece cover, rather than a cover for covering a display device, and a separately provided cover for covering a lens, as recited in Claims 11, 22, and 33.

It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight

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considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, the Applicant respectfully requests the withdrawal of the obviousness rejection of Claims 11, 22, and 33. Additionally, the claims that depend from Claims 11, 22, and 33 are considered allowable for at least the reasons advanced for the independent claim from which they respectively depend.

Newly added Claims 43-66 are considered allowable for at least the reasons advanced for the independent claim from which they respectively depend.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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